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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,046	10/15/2003	Joseph W. St. Geme III	A-59941-4 (467084-68)	7511
7590	05/13/2004		EXAMINER	
Richard F. Trecartin DORSEY & WHITNEY LLP Suite 3400 Four Embarcadero Center San Francisco, CA 94111-4187			GRASER, JENNIFER E	
			ART UNIT	PAPER NUMBER
			1645	
DATE MAILED: 05/13/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/687,046	ST. GEME, JOSEPH W.	
	Examiner	Art Unit	
	Jennifer E. Graser	1645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) ____ is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) 1-16 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. ____ .
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____ .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: ____ .

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Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 2 and 8-11, drawn to recombinant Haemophilus adhesion proteins, classified in class 424, subclass 256.1.
 - II. Claims 3-7, drawn to nucleic acid, classified in class 453, subclass 23.7.
 - III. Claims 12 and 13, drawn to compositions comprising antibodies which bind to a Haemophilus adhesion protein, classified in class 424, subclass 130.1.
 - IV. Claims 14 and 15, drawn to peptides of SEQ ID NOS: 18-52, classified in class 530, subclass 300. NOTE: Applicant must elect no more than 5 peptides to be searched. This is a Restriction Requirement, not a species election.
 - V. Claim 16, drawn to an antibody which binds to a peptide, classified in class 530, subclass 387.1. NOTE: Applicant must elect no more than 5 antibodies to be searched (by the peptide they bind to). This is a Restriction Requirement, not a species election.
2. The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups I-V are biologically, structurally and chemically different products and therefore are patentably distinct and independent inventions. It is noted that after a telephone conversation with Richard Trecartin, the Examiner agreed to search all of the different HAP proteins from different species of *H.influenzae*, i.e., SEQ ID NOS: 8, 10, 12, 14 and 16

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together, even though they technically represent different inventions. Normally, only one protein is allowed to be examined per application. Group IV comprises 34 different peptides. This exceeds the limit of SEQ ID Nos. which can be searched per application and it would require an undue burden on the part of the Examiner to search all 34 different peptides together. Normal restriction practice calls for the Election of a single peptide. However since 5 different proteins will be searched if Group I is elected, the Examiner will also allow Applicant to elect 5 peptides/antibodies to be searched if Groups IV or V is elected..

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, as shown by their different classification, and because the literature search for Groups I-V would not be coextensive, restriction for examination purposes as indicated is proper.

4. A telephone call was made to Richard Trecartin to request an oral election to the above restriction requirement, but did not result in an election being made.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

6. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal

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Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1645 Fax number is (703) 308-4242 which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Graser whose telephone number is (703) 308-1742. The examiner can normally be reached on Monday-Friday from 7:00 AM-4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



Jennifer E. Graser
PRIMARY EXAMINER